Docket No.: 8733.229.00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Mi S. NAM, et al.

Application No.: 09/534,723 Group Art Unit: 1772

Filed: March 24, 2000 Examiner: S. Hon

For: ALIGNMENT LAYER FOR LIQUID CRYSTAL DISPLAY DEVICE

REQUEST FOR RECONSIDERATION

Box Non-Fee Amendment
Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Office Action dated August 1, 2002, please consider the following remarks.

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the subject application.

In the Office Action dated August 1, 2002, claims 1-42 were pending and claims 1-6 are currently pending in this application.

The Examiner finally restricted claims 7-42, in view of the election of group I, claims 1-6 drawn to an oxygen alignment layer spacer. Accordingly, the Examiner examined claims 1-6 and claims 7-42 were withdrawn form consideration.

The Examiner rejected claims 1-6 under 35 U.S.C. § 112, second paragraph, and claims 1-6 were rejected under 35 U.S.C. § 101 as claiming the same invention as that of

claims 1-34 of Kwon et al. (U.S. Patent No. 6,399,165). Applicants respectfully traverse these rejections and hereby request reconsideration.

The rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph is respectfully traversed and reconsideration is hereby requested.

In rejecting claims 1-6 under 35 U.S.C. § 112, second paragraph, the Examiner states, "[i]t is unclear what is meant by the term 'photosensitive constituent'." (Office Action at 2.) The second paragraph of 35 U.S.C. § 112 requires that a claim need only "reasonably apprise those skilled in the art" as to their scope and be "as precise as the subject matter permits." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

Applicants respectfully direct the Examiner to the relevant claims and specification, for example, on page 7, lines 19-21, disclosing for example, "photo-sensitive constituents include a material selected from the group consisting of cinnamoyl derivatives." Accordingly, Applicants respectfully submit that the claims are in full compliance with 35 U.S.C. § 112, second paragraph.

Additionally, the Examiner states, "it is unclear what is meant by the term 'cinnamoyl derivative'." Applicants respectfully direct the Examiner to the specification, for example, pages 8, lines 13-22 and page 9, lines 1-6. Accordingly, Applicants respectfully submit that the claims are in full compliance with 35 U.S.C. § 112, second paragraph.

Additionally, the breadth of a claim is not to be equated with indefiniteness. See MPEP § 2173.04. Moreover, Applicants respectfully submit that the scope of the subject matter embraced by the claims is clear, Applicants have not otherwise indicated that the intended invention be of a scope different from that defined in the claims, and that one of ordinary skill in the art would recognize the scope of claims 1-6. Accordingly, Applicants respectfully submit that claims comply with 35 U.S.C. § 112, second paragraph.

The Examiner rejected claims 1-6 under 35 U.S.C. § 101 as claiming the same invention as the claims 1-34 of Kwon et al. Applicants respectfully traverse these rejections for at least the following reasons.

In determining whether a statutory basis exists for a double patenting rejection under 35 U.S.C. § 101, the question to be asked is the same invention is claimed twice. A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). See MPEP § 804(II)(A). The Examiner has failed to meet this burden. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 101 be withdrawn.

If the Examiner deems that a telephone call would further the prosecution of this application, the Examiner is invited to call the undersigned at (202) 496-7500. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. § 1.136, and any additional fees required under 37 C.F.R. § 1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Respectfully submitted,

Dated: October 18, 2002

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